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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,741	07/03/2003	John C. S. Koo	31045-101	5633
43914 7590 12/16/2010 JOSEPH SWAN, A PROFESSIONAL CORPORATION 1334 PARKVIEW AVENUE, SUITE 100 MANHATTAN BEACH, CA 90266				
EXAMINER MOHANDESI, JILA M				
ART UNIT		PAPER NUMBER		
3728				
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12/16/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,741

Applicant(s)

KOO, JOHN C. S.

Examiner

JILA M. MOHANDESI

Art Unit

3728

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9-34, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-34, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/08/2010
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/08/2010 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-4, 9-34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of JPH3-170101 (Kubota, Hirohiko) in view of Shin (US

4,658,514) and Gustin et al. (US 2,114,300). JPH3-170101 (Kubota, Hirohiko) discloses a shoe (see Figure 1), comprising a bottom surface that is adjacent to the ground in normal use and that has a plurality of indentations with lower-extending portions between the indentations; a sole that forms at least a portion of the bottom surface; an upper portion extending above the sole; and a plurality of small particles (fine particles or short fibers 8) bonded to at least some of the lower extending portions; wherein areas of the individual natural fibers and the lower-extending portions form at least a portion of the bottom surface of the outsole. JPH3-170101 also discloses a method and process to synergistically enhance an anti-slipping effect by applying an adhesive agent layer on the ground contact surface of a footwear sole and bringing individual short natural fibers or fine grains into collision against the adhesive agent layer by an electrostatic flocking method thereby fixing the natural fibers or grains. JPH3-170101 discloses that the boots 1 consist of a body part 2, an upper part 3 and a sole part 4 as the footwear sole. An anti-slipping design 6 consisting of rugged patterns is applied on the ground contact surface 5 of the sole part 4. This sole part 4 is coated with the adhesive agent over the entire surface thereof. A solvent type of a polyester urethane adhesive agent is used for the adhesive agent and is uniformly applied by spraying on the ground contact surface 5 to form the thin adhesive agent layer 7. After this adhesive agent layer 7 is applied, the individual short fibers 8 are brought into collision against the adhesive agent layer by the electrostatic flocking method, by which the individual short natural fibers are fixed and implanted. The short natural fibers 8 are implanted approximately perpendicularly to the coated surface of the adhesive agent layer 7, side wall surfaces 6a and the upper

base surfaces 6b, lower base surfaces 6c and recessed surfaces 6d, see Figures 1 and 2. JPH3-170101 does not appear to teach the indentations being predominantly being uncoated with said individual natural fibers. However JPH3-170101 clearly discloses that the individual short natural fibers can be flocked over either the entire ground-contacting surface of the sole, or a portion thereof, regardless of whether the ground-contacting surface is smooth or textured. Shin '514 teaches a shoe comprising a bottom surface that is adjacent to the ground in normal use and that the sole of a shoe has a plurality of protrusions 76 and a plurality of indentations (slots 50, see col. 3, lines 10-23) with only the protrusions having ridges 78 applied thereto to aid in affording traction to the user. Shin '514 further teaches that the indentations (slots 50) are provided to act as hinges and allow bending of the sole. Shin '514 shows these indentations without any traction elements because this section does not touch the ground and the traction elements would prevent complete bending of the sole in these areas. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made; to make the indentations of JPH3-170101 predominantly uncoated with said small particles as taught by Shin '514 to effectively prevent slippage while providing more flexibility by better bending of the sole.

With respect to claim 1, JPH3-170101 discloses that examples of the short fibers and free particles include fiberglass, metal fibers, nylon, Kevlar, and other synthetic fibers, cotton, linen, wool, and other natural fibers, ceramic fibers or powder, or free powders wherein **rubber** or hard or soft resin materials is pulverized, or **leather powder** or ceramic powder particles, or a sand such as metallic sand or silica sand. Although

wood and paper can be construed as natural fibers JPH3-170101 does not explicitly disclose the small particles being at least one of wood and paper. Gustin et al. discloses that it is old and conventional to use wood fiber and paper dust as materials for making shoe soles. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use wood or paper as part of the natural fibers used for the small particles of JPH3-170101 as taught by Gustin et al. since wood or paper are considered as natural fibers.

With respect to claims 3-4, 21-23 and 31-32, JPH3-170101 discloses that the adhesive agents that are applied to the ground-contacting surface of the footwear sole, can be any of the following adhesives such as the poly-ester-group urethane adhesives, polyether-group urethane adhesive, rubber-group adhesives such as NR-system, chloroprene-group NBR-system and SBR-group rubber adhesives, and may be of a solvent-group type or aqueous group type, where either type may be used favorably.

Any of the above adhesives can be construed as a temporary adhesive since they are prone to reduction in adhesive strength over time due to temperature, pressure or contact with fluids or rough surfaces. The "temporary adhesive" of claim 21 has no reference point and is met by the above adhesives such as rubber-group adhesives and aqueous group type adhesives as the particles of JPH3-170101 will eventually wear off. Accordingly, when applying the knowledge of the adhesive to the amount of time "days" and "weeks" in claims 22 and 23, it would depend on the amount of time desired for the particles to remain on the shoe, and would have been obvious to one of ordinary skill in the art to select the adhesiveness of the adhesive to be used to cover a certain time-

wear parameter, since the amount of time, "days" or "weeks" are result determined parameters and such would have been well within the expedient and obvious to the ordinary skilled artisan.

Furthermore the choice of particular range of adhesiveness is obvious, as the said values could be arrived at by routine trial or by the application of normal design procedure; such selection does not produce in the present case any unexpected effect. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the adhesiveness of the adhesive, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

JPH3-170101 will have at least 1,000 small particles bonded to the at least some lower extending portions; the small particles are bonded to the at least some of the lower extending portions using adhesive material; the small particles have been bonded directly onto the at least some of the lower extending portions; the sole is sufficiently durable for commercially acceptable outdoor use and the sole includes an outsole that is comprised of solid rubber (Shin '514, see column 2, lines 59-62) or other wear-resistant material (JPH3-170101, thermoplastic resin such as PVC or the footwear sole can use any sole material that has been fabricated using a well-known conventional method); the small particles cover at least 50% of the portion of the bottom surface that normally comes into contact with the ground (see Figures 1 and 2); the sole is sufficiently strong for commercially acceptable outdoor use; the bottom surface has at

least five indentations (see Figures 1 and 2); at least some of the indentations are very narrow (see Figure 1); at least one of the indentations appears to be approximately 1-2 millimeters in width (see indentations in forefoot area); at least some of the indentations are closely spaced; at least two of the indentations appear to be separated from each other by no more than approximately 2 millimeters. Furthermore, it would have been an obvious matter of design choice to modify the size of the indentations, since such a modification would have involved a mere change in the size of a component. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

With respect to claims 13-18, it appears that the ASTM tear resistance and abrasion resistance requirements are standards, therefore, it would be well within the skill of one of ordinary skill in the art to make a sole to meet these requirements. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole of the references as applied to claim 1 above meet the tear and abrasion resistance standards.

With respect to claim 19, JPH3-170101 discloses that the outsole can be made of thermoplastic resin such as PVC or the footwear sole can use any sole material that has been fabricated using a well-known conventional method. Shin '514 discloses that

outsoles made of solid rubber. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the outsole of JPH3-170101 as taught by Shin '514, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-4, 9-34 and 36-37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-9, 11, 13-19, 25 and 26 copending Application No. 11/530,419 in view of Shin '514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed structure of the application may be wholly derived from

the claimed subject matter of the copending application. Both applications are directed to a shoe, comprising: an outsole having a bottom surface; and an upper extending above the outsole, wherein the outsole is comprised of: a base material that includes a plurality of indentations and lower-extending portions and a plurality of small particles, wherein the small particles are bonded to at least some of the indentations and/or the lower-extending portions, and wherein areas of the small particles and the lower-extending portions form at least a portion of the bottom surface of the outsole. Shin '514 teaches a shoe comprising a bottom surface that is adjacent to the ground in normal use and that the sole of a shoe has a plurality of protrusions 76 and a plurality of indentations (slots 50, see col. 3, lines 10-23) with only the protrusions having ridges 78 applied thereto to aid in affording traction to the user. Shin '514 further teaches that the indentations (slots 50) are provided to act as hinges and allow bending of the sole. Shin '514 shows these indentations without any traction elements because this section does not touch the ground and the traction elements would prevent complete bending of the sole in these areas. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the indentations of application No. 11/530,419 predominantly uncoated with said small particles as taught by Shin '514 to effectively prevent slippage while providing more flexibility by better bending of the sole.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-4, 9-34 and 36-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S.

Patent No. 7,191,549 in view of Shin '514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed structure of the application may be wholly derived from the claimed subject matter of the Patent '549. Both the instant application and Patent '549 are directed to a shoe, comprising: an outsole having a bottom surface; and an upper extending above the outsole, wherein the outsole is comprised of: a base material that includes a plurality of indentations and lower-extending portions and a plurality of small particles, wherein the small particles are bonded to at least some of the indentations and/or the lower-extending portions, and wherein areas of the small particles and the lower-extending portions form at least a portion of the bottom surface of the outsole. Shin '514 teaches a shoe comprising a bottom surface that is adjacent to the ground in normal use and that the sole of a shoe has a plurality of protrusions 76 and a plurality of indentations (slots 50, see col. 3, lines 10-23) with only the protrusions having ridges 78 applied thereto to aid in affording traction to the user. Shin '514 further teaches that the indentations (slots 50) are provided to act as hinges and allow bending of the sole. Shin '514 shows these indentations without any traction elements because this section does not touch the ground and the traction elements would prevent complete bending of the sole in these areas. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the indentations of Patent No. 7,191,549 predominantly uncoated with said small particles as taught by Shin '514 to effectively prevent slippage while providing more flexibility by better bending of the sole.

Furthermore, since Patent '549 claims a more specific embodiment than the instant application, once applicant has received a patent for a species or a more specific embodiment, he is not entitled to a patent for a generic or broader invention, because the more specific "anticipates" the broader. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Response to Arguments

5. Applicant's arguments filed 09/08/2010 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the above references are all directed to providing traction for a footwear.

Applicant argues that, the term "temporary adhesive" is well-understood to mean an adhesive that is not capable of withstanding significant amounts of strain or force and that is suitable for only short-term use. The term "temporary adhesive" of claim 21 has no reference point and is met by the above adhesives such as rubber-group adhesives and aqueous group type adhesives as the particles of JPH3-170101 which will eventually wear off. Accordingly, when applying the knowledge of the adhesive to the amount of time "days" and "weeks" in claims 22 and 23, it would depend on the amount of time desired for the particles to remain on the shoe, and would have been obvious to one of ordinary skill in the art to select the adhesiveness of the adhesive to be used to cover a certain time-wear parameter, since the amount of time, "days" or "weeks" are result determined parameters and such would have been well within the expedient and obvious to the ordinary skilled artisan.

Inasmuch as applicant has disclosed what is meant by "temporary adhesive" in the claims, any of the adhesives used by JPH3-170101 can be construed as a temporary adhesive since they are prone to reduction in adhesive strength over time due to temperature, pressure or contact with fluids and rough surfaces. The small particles of JPH3-170101 will eventually wear off and there is a great possibility that some of the particles will wear off within no more than 3 minutes, or 3 days or 3 weeks when worn outdoors since they can come in contact with contact with rough surfaces and fall off. The "temporary adhesive" of claim 21 has no reference point and is met by the above adhesives such as rubber-group adhesives and aqueous group type adhesives as the particles of JPH3-170101 will eventually wear off. Accordingly, when applying the knowledge of the adhesive to the amount of time "days" and "weeks" in claims 22 and 23, it would depend on the amount of time desired for the particles to remain on the shoe, and would have been obvious to one of ordinary skill in the art to select the adhesiveness of the adhesive to be used to cover a certain time-wear parameter, since the amount of time, "days" or "weeks" are result determined parameters and such would have been well within the expedient and obvious to the ordinary skilled artisan.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is (571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
12/14/2010